

4/17/01

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Paper No. 15
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Post Office

Serial No. 74/523,981

John A. Clifford of Merchant & Gould P.C. for The Post Office.

Melvin T. Axilbund, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Chapman, Bottorff and Drost, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On May 12, 1994, The Post Office (a United Kingdom corporation located in London, England) filed an application to register the mark BRITISH POST OFFICE for the following goods and services, as amended:

(1) "electrical, electronic and optical apparatus and instruments, all for use in handling, processing and sorting of goods, namely address readers, sorters, bar code readers, optical reading machines for sorting packets and letters, optical reading machines for reading addresses or address codes on packets and letters and applying corresponding machine-readable optical indicia thereon for further sorting, electrical and electronic machines for applying machine-readable optical indicia to packets and letters;

computers, computer programs, magnetic discs and tapes, all for the storage and transmission of data in the field of handling, processing, sorting and tracking goods; and parts for all the aforesaid goods" in International Class 9;

(2) "paper cardboard, cardboard articles, namely boxes, dividers for boxes, tubes; filing trays; stamp dispensers; packaging materials, namely paper bags, boxes, mailing tubes, plain wrapper paper, fillers, and envelopes; printed matter, namely special handling forms, pricing lists, instruction sheets in the use of postal services; printed postcards and greeting cards; printed tickets, blank and printed labels; philatelic products, namely stamps, collection books, stamp mounting materials; stationery; office requisites, namely stamp dispensers, blank address books, blank address cards and card files, and writing paper; postal money orders; postal special handling orders; maps; blank paper and paper cards for the recordal of computer programs and data; printed instructional and teaching materials in the fields of packaging, addressing and delivery options for goods and correspondence and for stamp collecting" in International Class 16;

(3) "transmission of messages, telegrams, information and data by manual, mechanical, electronic, optical, telephone, telex, cable, computer and satellite means" in International Class 38;

(4) "collection, storage and delivery of correspondence, packets, packages, parcels, newspapers, freight and of goods, all by road, rail, air or water; courier services; unloading of cargo; rental of mailboxes; guarded transport of valuables; rental of vehicles; freight forwarding, warehousing; rental of warehouses" in International Class 39; and

(5) "catering services; computer programming for others; chemical technological research; materials testing; industrial design and packaging design services; engineering drawing;

engineering services; provision of facilities for exhibitions; printing; security consultations" in International Class 42.

The application is based on applicant's assertion of a bona fide intention to use the mark in commerce which the U.S. Congress may regulate. Applicant disclaimed the words "POST OFFICE."

The Examining Attorney has finally refused registration on two grounds: (1) that applicant lacks authority to use "post office" under 18 U.S.C. §1729, and (2) that the mark is primarily geographically descriptive under Section 2(e)(2) of the **Trademark Act**, 15 U.S.C. §1052(e)(2).

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

We consider first the refusal to register under 18 U.S.C. §1729, and we must address the Examining Attorney's basis for this specific refusal to register. As explained in the Trademark Manual of Examining Procedure at TMEP §1205.01, various federal statutes prohibit or restrict the use of certain, words, names, marks, insignia, seals, etc. In that same section of the Manual there is further explanation, as follows:

Usually the statute will define the appropriate use of a designation and will prescribe criminal penalties or civil remedies for improper use. However, the statutes themselves do not provide the basis for refusal of trademark registration. ... If a statute provides that a specific party or government agency has the exclusive right to use a designation, and a party other than that specified in the statute has applied to register such designation, the examining attorney must refuse registration under all appropriate sections of the **Trademark Act** and reference all relevant statutory provisions.

The Manual goes on to explain various possible refusals to register under the **Trademark Act**, such as, applicant's use of the mark would be unlawful under the referenced statute (Sections 1 and 45 of the **Trademark Act**, 15 U.S.C. §§1051 and 1127); or Section 2(a), 15 U.S.C. §1052(a), falsely suggesting a connection with the institution or person specified in the statute; or Section 2(b), 15 U.S.C. §1052(b), matter comprising a flag, coat of arms, etc.

The Examining Attorney described this particular refusal as "a refusal based on the federal criminal code."¹

¹ The Examining Attorney stated in his brief on appeal that registration was not refused under Section 2(a) because although the words "post office" in applicant's mark "may falsely suggest a connection with the United States Postal Service, the additional term BRITISH militates against [such] an inference..." (emphasis in original).

(Brief, p. 3.) However, as is clear from the TMEP, refusals to register trademarks must be grounded in the Trademark Act. Based on the arguments and record before us, we construe the Examining Attorney's refusal to register under 18 U.S.C. §1729 to be one based on Sections 1 and 45 of the Trademark Act, i.e., that applicant's use of this mark would be unlawful under 18 U.S.C. §1729.

The specific statute, 18 U.S.C. §1729 "Post office conducted without authority," reads, in its entirety, as follows:

Whoever, without authority from the Postal Service, sets up or professes to keep any office or place of business bearing the sign, name, or title of post office, shall be fined under this title.

It is important to note that inasmuch as 18 U.S.C. §1729 is a criminal statute, it must be strictly construed. See United States ex rel. Federal Bureau of Investigation v. Societe Anonyme Francaise M. Bril and Co., __ F. Supp. __, 187 USPQ 685, 688 (D.D.C. 1975).

The Board cases regarding unlawful use require a high standard be met, i.e., clear and convincing evidence that use would constitute a material violation of the applicable law. In fact, the Board has stated in the past that we will normally hold use of a mark in commerce unlawful only

when the issue of lawfulness has previously been determined by a court or governmental agency having competent jurisdiction under the statute involved, or where there has been a per se violation of a material portion of the statute regulating the sale of a party's goods and/or services. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992); *Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d 2045 (TTAB 1988); and *Satinine Societa in Nome Collettivo di S.A. e M. Usellini v. P.A.B. Produits et Appareils de Beaute*, 209 USPQ 958 (TTAB 1981). Here a criminal statute is involved, which makes it even more imperative that any violation be a clear per se violation of a material portion of the statute or determined by a court having competent jurisdiction under the statute.

From the record before us, we cannot say that if applicant commences use of its applied-for mark in commerce which may be regulated by Congress, such use would be unlawful under 18 U.S.C. §1729, as would constitute a basis for refusal under Sections 1 and 45 of the **Trademark Act**.

We turn now to the refusal to register under Section 2(e)(2). The Examining Attorney contends that the primary significance of the term BRITISH is geographic; that the addition of the generic or highly descriptive words "POST

OFFICE" to the geographic term does not negate the geographic nature of applicant's mark; and that because applicant's goods and services would come from the geographical place named, a public association with the place named will be presumed.

In support of the refusal to register, the Examining Attorney submitted the following dictionary definitions:

(1) BRITISH, "adj. 1. of or pertaining to Great Britain or its inhabitants..., n. 3. the people native to or inhabiting Great Britain..., " Random House Unabridged Dictionary (2nd ed.);

(2) BRITISH, "adj. 1. Of, pertaining to, or characteristic of Great Britain, the United Kingdom, or the British Empire..., n. 1. (used with a pl. verb) The people of Great Britain..., " The American Heritage Dictionary (2nd ed.); and

(3) POST OFFICE, "1. an office or station of a government postal system at which mail is received and sorted, from which it is dispatched and distributed, and at which stamps are sold or other services rendered..., " Random House Unabridged Dictionary (2nd ed.).

Applicant argues that "undue focus has been placed on the word BRITISH and insufficient consideration has been given to the words POST OFFICE as part of a composite mark" (brief, p. 3); and that applicant's wide variety of goods and services "demonstrate that it is unreasonable to

conclude that purchasers would perceive the goods and services as coming from Britain or the United Kingdom" (brief, p. 4). Further, applicant specifically argues as follows that the mark BRITISH POST OFFICE is unique and identifies applicant as the source of the goods and services:

(1) The mark BRITISH POST OFFICE is rather unique, first because it represents the trademark of a governmental entity of the United Kingdom (commonly referred to as 'Great Britain'), and because the Post Office of the United Kingdom is an entity with no competitors, much as the United States Postal Service is organized.

Thus, the fact that the term 'British' appears in BRITISH POST OFFICE does not make it geographically descriptive, but rather acts as the sole identifier to the sole organization empowered to deliver mail within the United Kingdom. (Applicant's October 31, 1997 response to an Office action, unnumbered pp. 3-4); and

(2) ...the term 'British' these days means of or pertaining to the United Kingdom, as there is no adjective derived from 'United Kingdom.'

It therefore follows that BRITISH POST OFFICE can only refer to one organization and one only, which is Applicant. There can be no other post office in the United Kingdom as a result of the statute, and indeed there is not one. Although the term 'post office' is, as the Examining Attorney suggests, a generic one in the sense that it describes an organization or

station as mentioned in the dictionary description, such businesses are **national** and once you identify the nation, you have identified the business. (emphasis in original) (Applicant's December 28, 1998 response to an Office action, p. 3).

In order for a mark, or a portion thereof, to be considered primarily geographically descriptive under Section 2(e)(2), it is necessary to show that (i) the mark or relevant portion is the name of a place known generally to the public, and that (ii) the public would make a goods and/or services/place association, that is, believe that the goods and/or services for which the mark or relevant portion is sought to be registered originate in that place. See, e.g., *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1402 (TTAB 1994); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988), citing *In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). Moreover, where there is no genuine issue that the geographical significance of a term is its primary significance, and where the geographical place named is neither obscure nor remote, a public association of the goods and/or services with the place may ordinarily be presumed from the fact that the applicant's goods and/or services come from the geographical place named in the

mark. See, e.g., *In re California Pizza Kitchen, Inc.*, supra; and *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848, 850 (TTAB 1982).

The dictionary definitions establish a prima facie case that the primary significance of the term "BRITISH" is geographic. Even though the term "BRITISH" encompasses "Great Britain,"² it is a specifically defined geographic area which is neither vague nor remote or obscure in the context of consumer awareness.

Considering the first part of the test, we find the evidence clearly establishes that "BRITISH" is the name of a place known generally to the public. It identifies a specifically defined geographic area, albeit involving more than one political entity. See *Burke-Parsons-Bowley Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 10 USPQ2d 1443, 1444 (6th Cir. 1989) ("Appalachian" in the mark APPALACHIAN LOG STRUCTURES found to define a specific large geographic region); and *In re Mid-West Abrasive Co.*, 146 F.2d 1011, 64 USPQ 400 (CCPA 1945) (based primarily on a dictionary definition, "Mid-West" found to refer to a

² We take judicial notice of the following definitions from The American Heritage Dictionary: (1) "Great Britain" is defined as "An island off the western coast of Europe, occupying 88,745 square miles and comprising England, Scotland, and Wales. Population 54,023,000. Also called 'Britain'"; and (2) "United Kingdom" is defined as "In full, United Kingdom of Great Britain and Northern Ireland...." See TBMP §712.01.

specific geographic place). Further, the term "BRITISH POST OFFICE" retains the primarily geographic character of "BRITISH" because, in the context of the entire mark, it indicates the nation in which the involved "POST OFFICE" is located, and from which the goods and services would emanate.

This leads to a consideration of the second part of the test, and there is no dispute that applicant is a corporation of the United Kingdom (Great Britain) and is located there. Thus, applicant has a specific and clear legal connection to the place named in the mark, and in fact, applicant is the government entity empowered to offer the goods and services of a "post office" in Great Britain. Applicant does not dispute that, if it commences use of this mark for these goods and services, the goods and services would emanate from Great Britain. Thus, we presume a public association of the goods and services with the place from the fact that applicant's goods and services would come from the geographical place named in the mark.

Because both parts of the enunciated test have been met, we find BRITISH POST OFFICE is primarily geographically descriptive. See *In re Compagnie Generale Maritime*, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993)(FRENCH LINE in stylized lettering for a wide variety

of goods and services held primarily geographically descriptive.) See also, *In re California Pizza Kitchen Inc.*, supra (the primary significance of the term "California" in the mark CALIFORNIA PIZZA KITCHEN for restaurant services held geographical - the terms PIZZA KITCHEN were disclaimed); and *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986) (the primary significance of the term "Nashville" in the mark THE NASHVILLE NETWORK for television program production services and distribution of television programming to cable television systems held geographical).

We are not persuaded otherwise by applicant's arguments to the contrary. The term "POST OFFICE" in the mark is generic (see applicant's December 28, 1998 response, quoted previously herein) or, at best, highly descriptive, of the goods and services involved herein.³ Because the geographical term identifies the nation offering the "post office" related goods and services, the

³ We are aware that several of the separate services identified in International Class 42 (e.g., "catering services," "chemical technological research") are certainly not typical of the goods and services most commonly offered by a post office. However, International Class 42 also includes services such as "packaging design services," and "provision of facilities for exhibitions," both of which are in the more typical realm of possible services offered by a post office. With regard to the other classes of goods and services, it is clear that each of those International Classes (9, 16, 38 and 39) involve the types of goods and services generally offered by a post office.

overall mark, BRITISH POST OFFICE, reinforces, rather than detracts from, the conclusion that "British" has primarily a geographical significance.

Applicant submitted copies of information from a private database of a few registrations owned by the United States Postal Service (all but one being expired) to show that the United States Postal Service has exclusive rights in its name (and presumably that applicant should have such rights in its name); and the Examining Attorney submitted photocopies of four registrations, two owned by the United States Postal Service, one by the U.S. Department of Commerce, and one by the British Tourist Authority, to show that all four issued under Section 2(f) of the Trademark Act or on the Supplemental Register, and that the Trademark Act applies to all entities equally.

The Trademark Act contemplates that there is a subset of applied-for marks which are not registrable on the Principal Register in the absence of a showing that the mark has achieved recognition as such. That is, the statute generally excludes from word marks that are registrable as inherently distinctive, words that are, for example, "merely descriptive" or "primarily geographically descriptive," absent a showing of acquired distinctiveness. See Wal-Mart Stores Inc. v. Samara Bros., 529 U.S. 205, 54

USPQ2d 1065, at 1068-1069 (2000). In the case now before us, the application is based on applicant's assertion of a bona fide intention to use the mark in commerce which may be regulated by Congress. Applicant has made no claim that use has commenced, and has not sought to invoke the benefits of Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

We conclude that consumers are likely to believe that BRITISH POST OFFICE is primarily geographically descriptive of applicant's various goods and services that would emanate from Great Britain.

Decision: The refusal to register under 18 U.S.C. §1729 is reversed, and the refusal to register under Section 2(e)(2) is affirmed.